

REMARKS

The present Amendment is in response to the Examiner's Office Action mailed January 13, 2009. Claims 8 and 13 are amended, and claim 23 is withdrawn. Claims 8-11 and 13-22 are now pending. Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicants' remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants' understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

Restriction Requirement

Claim 23 is subject to restriction as being directed to a nonelected species. Applicant respectfully traverses the restriction requirement. The Examiner has restricted claim 23 on the grounds that "claim 23 describes an alternate embodiment in which a diffraction grating is not used, resulting in a prismatic beam steering device."

Inasmuch as claim 23 is restricted as omitting elements of the elected species, it must be shown to be subject to restriction as a subcombination. A combination and subcombination are distinct and subject to restriction "if it can be shown that a combination as claimed: (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in another materially different combination." These requirements are not satisfied in this case. In particular, a diffraction grating by itself is well known and clearly unpatentable and therefore the elements of the subcombination are required to show patentability.

Claim Objections

Claims 13 and 17-22 are objected to for informalities. By this amendment claim 13 has been amended as suggested by the examiner. The objection is therefore overcome.

Rejection Under 35 U.S.C. § 103

The Examiner rejects claims 8-11 and 14-16 under 35 U.S.C. § 103 as being unpatentable over U.S. Publication No. 2003/0193974 of *Frankel et al. (Frankel)*. Applicants traverse the Examiner's rejection for obviousness on the grounds that the cited reference fails to teach or suggest each and every element of the rejected claims for at least the reasons pointed out in the previous amendment and response.

Furthermore, by this amendment claim 8 has been amended to recite, in combination with the other elements of the claim, first and second prisms "wherein the first and second prism each include first and second faces that are angled with respect to one another, wherein the first face of the first prism is parallel the first face of the second prism and wherein the second face of the first prism is parallel to the second face of the second prism." Applicant notes that no references, in particular *Frankel*, have been cited as teaching these elements in combination with the other elements of the claim. Claim 8 is therefore allowable for at least this reason.

Claims 9-11 and 14-22 depend on claim 8 and are therefore allowable for at least the reasons discussed hereinabove.

Allowable Subject Matter

Claims 13 and 17-22 are allowed, subject to the correction of informalities noted by the examiner. By this amendment claim 13 has been amended as suggested by the examiner. Claims 13 and 17-22 are therefore in condition for allowance.

CONCLUSION

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to **Deposit Account No. 23-3178**: (1) any filing fees required under 37 CFR § 1.16; and/or (2) any patent application and reexamination processing fees under 37 CFR § 1.17.

Dated this 9th day of April, 2009.

Respectfully submitted,

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